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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SHIBRU, HELEN	
			ART UNIT 2484	PAPER NUMBER
			NOTIFICATION DATE 01/24/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/572,580

Applicant(s)

TANAKA, KOUJIROU

Examiner

HELEN SHIBRU

Art Unit

2484

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments, filed 11/09/2010, have been entered and made of record. Claims 1-11 are pending.

Response to Arguments

2. Applicant's arguments filed 11/09/2010 have been fully considered but they are not persuasive. See the reasons sets forth below.

First the Examiner would like to point out that during the interview conducted on October 26, 2010, the proposed amendment in the agenda was discussed in view of the applied prior arts. The Examiner didn't agree that the currently amended claims would overcome the applied prior arts.

Applicant states, "Applicant has amended claim 10, which is now directed to a storage medium. Because storage medium is a manufacturer, it is submitted that claim 10 is directed to statutory subject matter."

In response, the Examiner respectfully disagrees. The present Application PG PUB paragraph 0128 discloses the storage medium can be any recording medium which can be accessed at random. The signal may be included in the stated **"any recording medium which can be accessed at random."** The specification does not explicitly exclude signal. In addition, the claimed "computer readable medium" includes both transitory and non-transitory embodiments. The amendment made to the claim does not

exclude transitory embodiments, and therefore the claim is still directed to non statutory subject matter. In view of the above response and the rejection sets forth below under 35 USC § 101 is maintained.

Applicant states, "a display of the title information of one of the contents which has been decided, based on the source ID applied to the one of the contents and said first source ID list, to be non-reproducible ... can be distinguished from a display of the tile information of the one of the contents if the one of the contents has been decided to be reproducible, as claimed in amended claim 1."

Although the Examiner agrees that Rebaud does not specifically teach displaying the non reproducible content in such a manner to distinguish it from the reproducible content on display screen, Reabud teaches displaying a listing of available media content from the media service provider on the device's user interface (see paragraph 0042). The displayed media content inherently includes title information. Rebaud teaches the list of approved device IDs 111 contains an identification of the media rendering client devices that are approved for the delivery of a particular content (see paragraph 0021). In addition Rebaud teaches the media items are associated with rating. Rating varies depending on the type of media content (see paragraphs 0022-0023). In paragraph 0040 Rebaud teaches, the media server delivery system allow different levels of security or access rules to be

applied to different sets of media content. This feature is implemented by maintaining a separate list 111 of approved device IDs for each category of media content. Rebaud teaches when determining whether a device is allowed to access a particular media item, the delivery system uses the appropriate list 111 of approved devices depending on the media content that has been requested. Therefore Rebaud teaches determining whether the media content is reproducible or not reproducible based on the said first source ID list and the said source ID.

Applicant agrees that the secondary reference, Yamamoto, display unit 207 displays normal buttons for corresponding playback content that is playable, and displays grayed out buttons for corresponding playback content that is not playable. Therefore Yamamoto displays playable and non playable contents and distinguished the contents with normal buttons and grayed out buttons respectively.

Therefore the combination of the two prior arts teaches the limitation "a display of the title information of one of the contents which has been decided, based on the source ID applied to the one of the contents and said first source ID list, to be non-reproducible ... can be distinguished from a display of the title information of the one of the contents if the one of the contents has been decided to be reproducible," as claimed in amended claim 1. Rebaud teaches determining whether media content is

reproducible or not based on a source ID applied to the content and the said first source ID and displaying reproducible content, Yamamoto teaches displaying both playable content and non playable content in such a manner to distinguish both on the display screen by providing a normal and grayed out button respectively.

Similar reasoning applied for claims 10-11 argument.

In response to Applicant's request for supporting evidence for claims 7 and 9, the Examiner noted that Yamamoto paragraph 0112 teaches the claim limitation. Applicant noted that on the remark page 9 lines 8-10, Yamamoto discloses the display unit displays normal buttons for corresponding playback contents that is playable, and displays grayed out buttons for corresponding playback content that is not playable. Therefore Yamamoto teaches title list production section and providing icons and different color to distinguish contents.

The Examiner also hereby added additional supporting evidences.

Kunii (US PG PUB 2002/0150387) discloses in figure 54 and paragraphs 0111, and 0377 groups of icons corresponding to reproducible content data.

Iino (US PG PUB 2005/0229211) shows, in figure 12, a mark "x" (cross) for unviewable/unrecordable and a circle for recordable/viewable contents. See also paragraphs 0139-0149.

See also the rejection sets forth below.

In response to Applicant's request for supporting evidence for claims 3-4, the prior art of Miyake (US PG PUB 2006 0044975) discloses setting up information indicative of deletion in addition to reproduced content and unreproduced content.

Ando (US Pat No. 6, 259, 858) also discloses including flag (value 0 or 1) on PGI either to delete or keep content.

Rebaud teaches a reproduction permission/inhibition decision section and Applicant is reminded that the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of the above, the Examiner believes that the claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-9 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebaud (US PG PUB 2004/0261093) in view of Yamamoto (US PG PUB 2005/0203853).

Regarding claim 1, Rebaud discloses a content processing apparatus, comprising:

a first source ID list that indicates providing sources of contents whose reproduction is permitted (see paragraph 0021 the database 110 contains a list of approved device IDs 111; IDs 111 contains an identification of client devices that are approved for the delivery of particular media content; see paragraph 0040, separate list 111 of approved devices maintained for each category of media content (full right and not full right to receive media content));

a content reproduction section that reproduces contents stored in a storage medium (see paragraph 0029, received data decoded);

a reproduction permission/inhibition decision section that decides whether each of the contents is reproducible based on a source ID applied to the content and said first source ID list (see paragraph 0040, ID list 111 includes contents to be accessed, where the contents are categorized; and when determining whether a device is allowed to access a particular media item, the delivery system uses the appropriate list 111 of approved devices depending on the media content that has been requested) and

a display of the title information of the one of the contents which has been decided to be reproducible based on the source ID applied to the said one of the contents and the said first source ID list (see paragraphs 0022-0023, 0040 and 0042 and the response above).

Claim 1 differs from Rebaud in that the claim further requires a title list production section that reproduces a list of title information of the contents such that the a display of the title information of one of the contents which has been decided to be non-reproducible by the said reproduction permission/inhibition decision section can be distinguished from a display of the title information of the one of the contents if the one of the contents has been decided to be reproducible.

In the same field of endeavor Yamamoto teaches a title list production section that reproduces a list of title information of the contents such that the a display of the title information of one of the contents which has been decided to be non-reproducible by the said reproduction permission/inhibition decision section can be distinguished from a display of the title information of the one of the contents if the one of the contents has been decided to be reproducible (see figure 6 where the prior art shows playback content and content unique information with playability information (playable, not playable), see also paragraphs 0068-0075, 0079 and 0112; and argument response above).

Therefore in light of the teaching in Yamamoto it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rebaud by providing a title list and distinguishing permitted or inhibited contents and displaying the distinguished contents such that the user can identify the programs that the user has the right to view and proceed further action, for instance, editing, by identifying the two contents.

Regarding claim 2, Rebaud discloses a content reproduction apparatus (see media renderer client devices as shown in figure 1, figure 2 which shows one example of media rendering client device 200 for illustration purpose, and paragraph 0028) having a function of controlling a reproduction based on a second source ID list (see paragraph 0030 delivery system authenticates the media rendering device using a device ID 225; device ID identify a class of devices that share common trait; see paragraph 0039 a list of approved device IDs 225 is stored in service management database coupled to the system server) indicating providing sources of contents whose reproduction is permitted can be connected to said content processing apparatus (see connected media renderer client devices as shown in figure 1 using middelman server, 140),

said reproduction permission/inhibition decision section deciding, based on source IDs applied to the contents stored in said content reproduction apparatus and said second source ID list, whether the contents

stored in the said reproduction apparatus are reproducible on said content reproduction apparatus (see paragraphs 0030, 0040, 0043-0045 which content can be received by the device);

a display of the title information of the one of the contents which has been decided to be reproducible based on the source ID applied to the said one of the contents and the said first source ID list (see paragraphs 0022-0023, 0040 and 0042 and see also argument response above); and

Yamamoto discloses content processing apparatus further comprising a title information acquisition section that acquires title information of contents stored in said content reproduction apparatus (see figures 6 and 7, and paragraphs 0071, 0151-0153 and claims 1 and 6), and

the said title list production section produces a list of the title information of the contents stored in said content reproduction apparatus such that a display of the title information of one of the contents stored in the said content reproduction apparatus which has been decided to be non-reproducible by said reproduction permission/inhibition section can be distinguished from a display of the title information of the one of the contents stored in said content reproduction apparatus if the one of the contents stored in the said content reproduction apparatus has been decided to be reproducible (see figure 6 where the prior art shows playback content and content unique information with playability information (playable, not

playable), see also paragraphs 0068-0075, 0079 and 0112 and argument response above.

Claim 2 carries the motivation of claim 1 above.

Regarding claim 5, Yamamoto discloses a title list display section that displays the list of the title information produced by said title list production section (see figure 2, and paragraphs 0075, 0112 and 0160).

Regarding claim 6, Rebaud teaches reproduction permission/inhibition decision section further decides whether or not any content is reproducible based on reproduction restriction information applied to that content (see paragraph 0022-0023).

Regarding claim 8, Yamamoto discloses title list production section produces the list of the title information such that the title information of those contents which are decided to be reproducible and the title information of those contents which are decided to be non-reproducible are displayed separately from each other (see figure 6 which shows for instance playable contents 4444 and 5555 are separately displayed from not playable contents 6666 and 7777).

Regarding claims 7 and 9, Yamamoto teaches displaying the non-reproducible contents separately from the reproducible contents and distinguishing the playable content from the not playable content with different icons, and color/luminance information (see paragraph 0112,

grayed (color/luminance) and normal buttons (icons); and see also the response above).

Regarding claims 10-11, the limitation of claims 10-11 can be found in claims 1-2. Therefore claims 10-11 are analyzed and rejected for the same reasons as discussed in claims 1-2 above.

5. Claims 3-4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebaud (US PG PUB 2004/0261093) in view of Yamamoto (US PG PUB 2005/0203853) and further in view of Official Notice.

Regarding claim 3 and 4, although both Rebaud and Yamamoto teaches performing a decision to distinguish the non reproducible content from the reproducible content, both prior arts fails to specifically teach deleting the non playable content from a storage medium of the said content processing apparatus or from the said content processing apparatus.

Official Notice is taken that it is notoriously well known in the reproducing and recording art to delete selected content. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above proposed combination by providing a deleting process in order to save more data and create additional space by discarding selected and distinguished content(s). See the above supporting evidences.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 is directed to "a computer-readable storage medium" which is presumed to include both transitory and non-transitory embodiments of "medium" and, as such, the claimed is presumed as being directed to non-transitory subject matter, i.e. computer readable medium includes transitory embodiment. In the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a "a computer readable medium" covers a signal *per se*." Therefore the claims are directed to non-statutory subject matter. This rejection can be overcome by narrowing the claims to non-transitory embodiments.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action

and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/
Examiner, Art Unit 2484
January 14, 2011